

REMARKS

Responsive to the Office Action mailed October 26, 2006, Applicants provide the following. The claims have not been amended, therefore, fourteen (14) claims remain pending in the application: Claims 13-25 and 52. Reconsideration of claims 13-25 and 52 in view of the amendments above and remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone Thomas F. Lebens at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Common Ownership of Pending Application and

U.S. Patent No. 6,543,365 (Vasel et al.)

1. The pending Application (i.e., Application No. 10/731,684) and U.S. Patent No. 6,543,365 (Vasel et al.) were, at the time the invention of the pending Application was made, owned by or under an obligation of assignment at the time of invention to PEPPERBALL TECHNOLOGIES, INC. Applicants note that in 2002 JACOR TACTICAL SYSTEMS, INC. changed its name to PEPPERBALL TECHNOLOGIES, INC. and all rights and interests of any patents, patent applications and inventions owned by JACOR TACTICAL SYSTEMS, INC. were assigned to PEPPERBALL TECHNOLOGIES, INC. or under an obligation to be assigned to PEPPERBALL TECHNOLOGIES, INC.

Claim Rejections - 35 U.S.C. §102

2. Claim 16 stands rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 4,448,106 (Knapp). Applicants respectfully traverse this rejection. Claim 16 is not anticipated by the Knapp reference because the Knapp

reference fails to describe at least each element of claim 16. Specifically, the Knapp references fails to describe at least “an inhibiting substance” and also fails to describe at least “an inhibiting substance contained within the volume” as recited in claim 16. Knapp describes a “system for identifying a hard target from a distance” (Knapp, abstract), and continues to describe a number of identifying substances such as paint, dye, a light beacon, and a flare and/or smoke identifier. (See Knapp, col. 5, lines 29-67). Knapp fails to describe the use of an “inhibiting substance.” The office action mailed October 26, 2006 suggests “that the substance, contained within the volume of the projectile of Knapp, marks the target thereby *inhibiting* the target from escaping.” However, marking does not inhibit any escape. The marking only marks. There is no inhibiting and any inhibiting would require other forces. Simply marking has no effect on inhibiting. Therefore, the Knapp patent fails to teach an inhibiting substance.

Furthermore, Knapp fails to describe at least “additional stabilizers positioned on the exterior of the second part” as recited in claim 16. The office action relies upon reference numbers 92 and 92’ that are extension of the paddles 91, 91’, 91’’ in attempts to demonstrate that Knapp describes additional stabilizers. However, reference numbers 92 and 92’ describe the paddles which the examiner has already equated to the claimed “stabilizing fins.” Further, the elements 92 and 92’ are not positioned on the exterior of the second part” as claimed and instead are on the paddles 91, 91’, 91’’. Specifically, the Knapp patent states “[e]ach paddle 91 is provided with an end portion 92 at right angles to the main portion of the paddle” (Knapp, col. 7, lines 20-21). Therefore, the Knapp patent states that the end portions 92 are part of the paddle and not an additional stabilizer “positioned on the exterior of the second part” as claimed. Thus, the Knapp patent fails to describe every element of claim 16, and thus, claim 16 is not anticipated by the Knapp patent.

3. Claim 52 stands rejected under 35 U.S.C. § 102(b), as being anticipated by either U.S. Patent No. 4,448,106 (Riffet) or U.S. Patent No. 2,112,758

(Blacker). Applicants respectfully traverse these rejections because the Riffet and Blacker patents both fail to describe every element as recited in claim 52. For example, claim 52 recites in part, "a projectile comprising ... an inhibiting substance contained within the volume ... wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target." Neither the Riffet or Blacker patents describe at least a projectile with an inhibiting substance that is dispersed into a cloud upon impact with a target. Therefore, claim 52 is not anticipated by the Riffet and Blacker patents.

Further, the office action failed to address Applicants arguments in the pending office action of October 26, 2006 (MPEP 707.07(f)). It is respectfully submitted that Applicants have demonstrated that the Riffet and Blacker patents fail to teach each limitation as recited in claim 52. Therefore, Applicants respectfully request the rejection be reversed.

Claim Rejections - 35 U.S.C. §103

4. Claims 13-25 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,543,365 (Vasel et al.) in view of U.S. Patent No. 5,361,700 (Carbone).

Applicants have made a statement above indicating that the pending Application and the Vasel patent were, at the time the invention of the pending Application was made, owned by or under an obligation of assignment at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. §103(c) recites:

subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that both the Vasel patent and the present application were assigned and/or under an obligation of assignment at the time the invention of the pending

application was made to PEPPERBALL TECHNOLOGIES, INC. In 2002 JACOR TACTICAL SYSTEMS, INC. changed its name to PEPPERBALL TECHNOLOGIES, INC. and all rights and interests of any patents, patent applications and inventions owned by JACOR TACTICAL SYSTEMS, INC. were assigned to PEPPERBALL TECHNOLOGIES, INC. or under an obligation to be assigned to PEPPERBALL TECHNOLOGIES, INC.

The pending application has a priority date of February 10, 2003 based on U.S. Provisional Application No. 60/446,657 that provides support for the claims of the pending application, and the Vasel patent issued on April 8, 2003.

The Vasel patent when initially filed as an application was owned by JAYCOR as evidenced by the Assignment executed on July 21, 2000 and recorded at Real/Frame 011009/0147. The Vasel patent was subsequently assigned while still pending as an application from JAYCOR to JAYCOR TACTILE SYSTEMS, INC. on July 17, 2001, as evidenced by the Assignment recorded at Reel/Frame 012043/0254. As described above, JAYCOR TACTILE SYSTEMS, INC. changed its name in 2002 to PEPPERBALL TECHNOLOGIES, INC. and the Vasel patent while still pending as an application was assigned to PEPPERBALL TECHNOLOGIES, INC., which is the same entity as JAYCOR TACTILE SYSTEMS, INC., on September 16, 2002 as evidenced by the Assignment recorded at Reel/Frame 013821/0290.

The subject application has a priority date of February 10, 2003 based on U.S. Provisional Application No. 60/446,657 filed after the September 16, 2002 assignment of the Vasel Patent to PEPPERBALL TECHNOLOGIES INC. The subject application was assigned from the Applicants to PEPPERBALL TECHNOLOGIES INC. on February 23, 2004, as evidenced by the Assignment recorded at Reel/Frame 014640/0281. Therefore, both the subject application and the Vasel patent were, at the time the invention was made, owned by or under obligation to be assigned to PEPPERBALL TECHNOLOGIES, INC. Because of the change of name from JAYCOR TACTILE SYSTEMS, INC. to PEPPERBALL TECHNOLOGIES, INC. Applicants

representatives inadvertently previously identified JAYCOR TACTILE SYSTEMS, INC. as the common owner.

Therefore, under 35 U.S.C. §103(c) the Vasel patent cannot be applied against the present application, and thus, Applicants respectfully request the rejection of claims 13-25 over Vasel in view of Carbone be withdrawn.

Further with regard to at least independent claim 13, Applicants respectfully submit that the Carbone patent fails to describe at least “a propulsion block positioned proximate to the stabilizing fins that maintains substantially all of the propulsion force behind the propulsion block and to evenly distribute the propulsion force to the projectile” as recited in claim 13. The office action equates the “gas-sealing disc” (reference No. 9) in the Carbone patent to the claimed propulsion block. The gas-sealing disc of Carbone, however, at least cannot evenly distribute the propulsion force to the projectile. The gas-sealing disc 9 will rupture at a weakest point causing the high-pressure gases to unevenly rush out at the site of the rupture, and therefore, exert a greater force on the projectile at or near the site of initial rupture. Therefore, the gas-seal disc of Carbone cannot be equated to the recited propulsion block of claim 13, and thus, a *prima facie* case of obviousness has not been shown.

The office action of October 26, 2006 in response to Applicants prior arguments suggests that:

[b]y preventing leaking the gases are allowed to build up thereby allowing a propulsion force to build up and be evenly distributed behind the seal rather than unevenly distributed by leaking around the seal, the gases are evenly distributed for the time before the seal ruptures. Since the present claims do not require a minimum time that the propulsion force be maintained behind the propulsion block, it is irrelevant that the seal of Carbone ruptures at some point (office action, page 4).

However, claim 13, for example, does not simply recite the establishing of an evenly distributed force. Instead, claim 13 recites in part “a propulsion block ... to evenly distribute the propulsion force to the projectile.” The fact that the Carbone patent requires the disc 9 to break before the force is applied to the projectile, and that the physics of breaking a disc through pressure requires that the pressure be released

unevenly, the Carbone patent does not teach or suggest a propulsion block that evenly distributes a propulsion force to the projectile. Therefore, Applicants respectfully submit that the Carbone patent fails to teach or suggest each element of claim 13, and thus, claim 13 and the claims that depend from claim 13 are not anticipated by the Carbone patent.

CONCLUSION

Applicants submit that the above remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: December 26, 2006

/Steven M. Freeland/

Steven M. Freeland
Reg. No. 42,555
Attorney for Applicant(s)
(858) 552-1311

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 552-1311